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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
20717

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on 20 February 2007

Signature Christine E. Benter

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Application Number	Filed
10/689,478	20 October 2003

First Named Inventor: Daniel S. PapenFuss

Art Unit	Examiner
1772	Marc A. Patterson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____.

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 51,457

Christine E. Benter
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20 February 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number: 10/689,478 **Examiner**: Marc A. Patterson

Applicant: Daniel S. Papenfuss, et al. **Art Unit**: 1772

Filing Date: 20 October 2003

Title: Tear Initiation and Directional Tear Films and Packages Made Therefrom

Customer Number: 30482

Docket Number: 20717

SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Status of Claims

The application includes Claims 1-67. Each claim requires a flexible multilayer packaging film comprising a first film layer, a second film layer, a third film layer and a fourth film layer. The external surface of the first film layer comprises a surface-roughened portion, and the external surface of the fourth film layer comprises at least one score-line. A limitation of the surface-roughened portion and the score-line intersecting at a perpendicular axis drawn between the first film layer and the fourth film layer is present in each claim.

In both the July 1, 2005 and the March 22, 2006 Office Actions, Claims 1-4, 6-13 and 17-23 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent 5,874,155 ("Gehrke et al."); Claim 5 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gehrke et al.; and Claims 14-16 and 24-67 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gehrke et al. in view of U.S. Patent 5,783,266 ("Gehrke") (with Gehrke apparently being relied upon solely for disclosure regarding a metallic coating).

On June 21, 2006, applicant filed a Notice of Appeal with a Pre-Appeal Brief Request for Review. The Support for the Pre-Appeal Brief Request for Review explained that Gehrke et al. do not, directly or indirectly, disclose, contemplate or suggest that each layer, or any layer other than the outer layer, of the film structure is knurled, roughened, nicked or cut to provide an easy-opening feature. In response, the Panel reopened prosecution.

In the next (October 19, 2006) Office Action, Claims 1-13 and 17-23 were rejected for obviousness under 35 U.S.C. §103(a), citing U.S. Patent 5,660,903 ("Andersen et al."), and Claims 14-16 and 24-67 were also rejected under 35 U.S.C. §103(a), citing Andersen et al. in view of Gehrke (again with Gehrke apparently being relied upon solely for disclosure regarding a metallic coating).

Applicant respectfully submits that clear errors are present in Examiner's reliance upon Andersen et al. and that the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, the rejections should be withdrawn and the claims should be allowed.

Non-Analogous Art

"To rely on a reference under 35 U.S.C. 103, it must be analogous prior art." (M.P.E.P. §2141.01(a)(I), Eighth Edition, August 2001, Latest Revision August 2006.) As further explained in In re Oetiker,

> In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. [Citation omitted.] Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" [citation omitted] – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

(24 USPQ2d 1443, 1445-1446 (Fed. Cir. 1992).)

Andersen et al. is a 60-page patent relating "to compositions, methods for manufacturing sheets, and articles of manufacture having a highly inorganically filled organic polymer matrix." (Column 1 lines 20-22.) However, the present application "relates to flexible packaging films, particularly, flexible multilayered packaging films which include a score-line and a surface-roughening portion." (Application, Page 1 lines 2-3). The sheets of Andersen et al., which may be flexible, are, nonetheless, not analogous to the flexible packaging films of the present application. Andersen et al. define "sheet" as follows:

> The term "sheet" as used in this specification and the appended claims is intended to include any substantially flat, corrugated, curved, bent, or textured sheet made using the methods described herein. The only essential compositional limitation is that the structural matrix of at least part of the sheet comprises a highly inorganically filled composite having a water-dispersable organic binder. The sheet may include other materials such as paper, organic coatings, ink, or other organic materials in addition to the highly inorganically filled/organic binder matrix portion.

(Column 19 lines 41-50.) Andersen et al. further explain,

> The preferred structural matrix of the sheets, containers, and other objects manufactured according to the present invention is formed from the interaction between inorganic aggregate particles, a water dispersable organic binder, and fibers. These are made into a highly moldable, workable, and uniform mixture by adding an appropriate amount of water and thoroughly mixing the components together. The amount of added water is preferably just enough to provide adequate workability and moldability, while maintaining a mixture that is form stable: that is, a mixture which will maintain its shape during hardening after being manufactured into the desired shape. In this case this is preferably a continuous sheet which will usually be calendered or otherwise finished using rollers and other manufacturing equipment utilized in the paper industry.

(Column 11 lines 12-26.) In contrast, the flexible packaging film of the present application is, generally, plastic packaging. ASTM International defines plastic as "a material containing as an essential ingredient an organic substance of large molecular mass, which is solid in its finished state and, at some stage in its manufacture or in its processing into finished articles, can be shaped by flow." (D 1695 – 96 (Reapproved 2001).) Several ASTM test methods are noted and incorporated by reference into the present application. (Application, Page 24 lines 1-10.)

The essential general characteristic of Andersen et al. is a highly inorganically filled composite having a water-dispersible organic binder. However, the essential general characteristic of the present application is an organic substance of large molecular mass. While Andersen et al. and the present application relate to packaging materials, Andersen et al. is not in the field of applicant's general endeavor. As explained and exemplified in In re Clay,

> Sydansk [a prior art reference applied against the claims of Clay] cannot be considered to be within Clay's field of endeavor merely because both relate to the petroleum industry. . . . Clay's field of endeavor is the *storage* of refined liquid hydrocarbons. The field of endeavor of Sydansk's invention, on the other hand, is the *extraction* of crude petroleum. The Board clearly erred in considering Sydansk to be within the same field of endeavor as Clay's.

(23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

Furthermore, Andersen et al. is not reasonably pertinent to the particular problem addressed by the present application. In re Clay further explains,

> A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

(*Id.* at 1061). Andersen et al. discuss the general problem to which it relates as follows:

> In light of the foregoing, the debate should not be directed to which of these materials is more or less harmful to the environment, but rather toward asking: Can we discover or develop an alternative material which will solve most, if not all, of the various environmental problems associated with each of these presently used materials?

(Column 4 lines 37-42). Andersen et al. also discuss a specific problem, stating, "the present invention is directed to innovative compositions which solve the prior art problems of incorporating a high percentage of inorganic aggregates into the matrices of products which can be readily manufactured by machine, rather than individual hand manufacture of one product as a time (such as "throwing pots"). (Column 20 lines 18-23.) In contrast, the present application addresses the problem of the initiation and control of "the opening of packages formed from various flexible packaging film combinations." (Application, Page 1 lines 14-15.) The present application states,

> A flexible packaging film of the present invention may be easily torn apart manually. . . . In another aspect, the present invention relates to a package . . . having a tear initiation area which allows the package to be easily opened manually. . . . In still another aspect, the present invention relates to a package . . . having a controllable tear zone which affords directional control during the opening process of the package.

(Application, Page 3 line 27 – Page 4 line 6). The inventors of the present application would not have looked to Andersen et al. in addressing the problem of an easy-open package. As stated in In re Horn, Horn, Horn, and Horn, "For the teachings of a reference to be prior art under 35 USC 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention pertains." (203 USPQ 969, 971 (CCPA 1979).) Andersen et al. is neither in the same field of endeavor as the present application nor is it reasonably pertinent to the problem addressed by the present application. Therefore, Andersen et al. is non-analogous art, and the rejections of claims 1-13 and 17-12 as allegedly unpatentable over Andersen et al. and claims 14-16 and 24-67 as allegedly unpatentable over Andersen et al. in view of Gehrke cannot be sustained.

Lack of *Prima Facie* Case of Obviousness

Assuming *arguendo* that Andersen et al. is analogous prior art, the Examiner has failed to establish a *prima facie* case of obviousness.

According to the M.P.E.P., to establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria: Either the references cited or the knowledge generally available to one of ordinary skill in the art presents some suggestion or motivation to modify the reference or to combine references; the modification or combination presents a reasonable expectation of success; and the prior art reference or references teach or suggest all the claim limitations of the pending application. (M.P.E.P. § 2143 Eighth Edition, August 2001, Latest Revision August 2006.) In citing Andersen et al., the Examiner has failed to meet the required criteria.

The Examiner states, "Andersen et al fail to disclose a surface-roughened portion and score line intersecting at least at one axis drawn between the first film layer and fourth film layer when the film is in a lay flat condition." (October 19, 2006 Office Action, Page 3, first partial paragraph.) This limitation is required by every claim of the present application. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." (M.P.E.P. §2143.03 Eighth Edition, August 2001, Latest Revision August 2006, citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).) Andersen et al. do not teach or suggest all the limitations of claims 1-13 and 17-23, and the combination of Andersen et al. and Gehrke does not teach or suggest all the limitations of Claims 14-16 and 24-67.

The Examiner continues,

> Andersen et al fail to disclose a surface-roughened portion and score line intersecting at least at one axis drawn between the first film layer and fourth film layer when the film is in a lay flat condition. However, as stated above, Andersen et al disclose the score lines for bending the film. Therefore, one of ordinary skill in the art would have recognized the utility of varying the portion of the score line to obtain the desired bending. Therefore, the bending would be readily determined through routine optimization of the position of the score line by one having ordinary skill in the art depending on the desired use of the end product as taught by Andersen et al. It therefore would be obvious for one of ordinary skill in the art to vary the position of the score line, and therefore the degree of intersection, in order to obtain the desired bending, since the bending would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Andersen et al.

(October 19, 2006 Office Action, Page 3, first partial paragraph and first and second full paragraphs.) The present application relates to the intersection of a surface-roughened portion in one layer and a score-line in another layer to facilitate easy-opening of a packaging; it does not relate to facilitating bending. Additionally, the Examiner makes no mention of the surface-roughened portion in relation to the score-line in Andersen et al.

It is submitted that the Examiner is applying an improper obvious to try rationale in support of the obviousness rejection, stating that, through routine optimization or experimentation, the limitation of a surface-roughened portion and score-line intersecting as in the present application would result. As explained by the Federal Circuit in *In re Eli Lilly & Co.*,

> An "obvious-to-try" situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.

(14 USPQ2d 1741, 1743 (Fed. Cir. 1990). In In re Yates, the Court of Customs and Patent Appeals stated that, in some instances, routine optimization may be used to support an obviousness rejection. (211 USPQ 1149, 1151 (CCPA 1981). However, it went on to explain,

> The problem, however, with such "rules of patentability" and the ever-lengthening list of exceptions which they engender) is that they tend to becloud the ultimate legal issue – obviousness – and exalt the formal exercise of squeezing new factual situations into preestablished pigeonholes. Additionally, the emphasis upon routine experimentation is contrary to the last sentence of section 103. [Patentability shall not be negatived by the manner in which the invention was made.]

(*Id.*) The Examiner has failed to explain how Andersen et al. sufficiently teach or provide certain direction for an intersection (via a drawn perpendicular axis) of the surface-roughened portion of the first film layer and the score-line of the fourth film layer. In re Yates does not permit reliance upon a routine experimentation/optimization argument. Furthermore, Ex parte Levengood does not permit reliance upon capabilities of one of ordinary skill in the art:

> A statement that modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

(M.P.E.P. §2143.01(IV), Eighth Edition, August 2001, Latest Revision August 2006, citing Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)). Ex parte Levengood continues,

> That one can *reconstruct* and / or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.

(28 USPQ2d at 1302.)

Andersen et al. teach a sheet comprising an inorganically filled matrix that may have a roughened finish (Column 13 lines 35-38) and that may be scored (Column 57 line 30 – Column 58 line 48). However, the Examiner has failed to indicate where Andersen et al. teach any intersection of the roughened finish and the scoring. Therefore, the Examiner has failed to present the requisite suggestion or motivation to modify Andersen and has failed to establish a *prima facie* case of obviousness.

Conclusion

In the October 19, 2006 Office Action, the Examiner relies upon the non-analogous art of Andersen et al. Additionally, assuming arguendo that Andersen et al. is analogous art, the Examiner fails to establish a *prima facie* case of obviousness. Therefore, Claims 1-67 of the present invention are patentable over Andersen et al. and Andersen et al. in view of Gehrke. The rejections should be withdrawn and the claims should be allowed.

Respectfully submitted,

Date: February 20, 2007

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